

that the Restriction Requirement provides no factual basis for asserting either independence or distinctness of these claims. The Restriction Requirement makes the following statements:

The inventions are distinct, each from the other because of the following reasons: Inventions I and II are related as process of making and product made. The inventions are distinct if it can be shown that either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another materially different process, such as electroless plating; electrolytic plating; soldering; or MOCVD. (Restriction Requirement, Page 2).

A restriction requirement must provide the particular factual basis for asserting that restriction is necessary:

The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given. (MPEP § 816, p. 800-56 (8th ed. rev. 1 February 2003)).

The Restriction Requirement fails to provide such a factual basis (as opposed to a “mere statement of conclusion”) indicating why the claims recite patentably distinct species--that is, a factual basis for asserting that: “the product as claimed can be made by another materially different process.” The Examiner does not identify how the allegedly “materially different processes” of electroless plating, electrolytic plating, soldering, and MOCVD are capable of making the structure as claimed in Claims 7-11 and Claims 18-22.

The Applicant respectfully traverses the Examiner’s conclusion for the following reasons. Restriction is only proper where the claims are independent or distinct. MPEP § 806. In passing on

questions of restriction, the claimed subject matter must be compared in order to determine distinctness and independence. MPEP § 806.01, p. 800-39. The Restriction Requirement concedes that the claims are not independent but are related (“Inventions I and II are related as process of making and product made”) (Emphasis added) (Restriction Requirement, Page 2).

Claim 1 is directed to a method as follows:

1. A method for fabricating a structure for receiving a wire bond, said method comprising the steps of:
 fabricating a substrate material having portions that form a substrate cavity within said substrate material;
 filling said substrate cavity with portions of a wire bond pad to form a wire bond cavity in said wire bond pad; and
 covering edge portions of said wire bond pad with passivation material.

Claim 7 is directed to a structure for receiving a wire bond that requires the use of the method as claimed in Claim 1:

7. A structure for receiving a wire bond, said structure comprising:
 a substrate material having portions that form a substrate cavity within said substrate material;
 a wire bond pad covering said substrate cavity wherein portions of said wire bond pad fill said substrate cavity to form a wire bond cavity in said wire bond pad; and
 passivation material that covers edge portions of said wire bond pad.

From the foregoing, the Applicant respectfully submits that it is clear that only a method of the type claimed in Claim 1 can form the structure as claimed in Claim 7. That is, there is not “another materially different method” that can make the structure of the invention as claimed in the Group II claims. Therefore, the Restriction Requirement accordingly has failed to establish that the

structure as claimed in Claims 7-11 and Claims 13-22 could be made by another materially different method than the method as claimed in Claims 1-6 and Claims 12-17.

With regard to the assertion that “Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper,” the Restriction Requirement fails to provide any factual basis for such conclusion.

With respect to distinctness of the Group I Claims (Claims 1-6 and Claims 12-17) from the Group II Claims (Claims 7-11 and Claims 18-22), the Restriction Requirement fails to satisfy any of the requirements for restricting the claims of the patent application. Accordingly, the Applicant respectfully requests that the restriction be withdrawn.

SUMMARY


If any issue arises, or if the Examiner has any suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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